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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,621	08/22/2000	Farzad Hiri	4397.32	9076

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ERICSSON INC.
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EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary

Application No.

09/643,621

Applicant(s)

HIRI ET AL.

Examiner

Md S Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 24, page no. 24, the phrase "The communications device recited in Claim 25" lacks antecedent basis because it appears that the "The communications device recited in Claim 25" should be "The communications device recited in Claim 23".

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 5-8, 13, 14 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik (U.S. Patent No. 6,327,356).

Regarding claims 1 and 13, Malik teaches establishing a first call link between the called party device and a first calling party device (fig.3; col.9, lines 27-67; 'first call between the called party and a first calling party' reads on the claim 'first call link between said called party device and a first calling party device').

Malik further teaches receiving a call request to the called party from a second calling party (fig.3; col.9, lines 27-67; 'the called party from a second calling party' reads on the claim 'called party device from a second calling party device').

Malik further teaches inherently placing the first call link on hold (fig.3; col.5, lines 31-56, col.9, lines 27-67; 'call' reads on the claim 'call link').

Malik further teaches accepting new call from the second calling party device to establish a connection between the called party device and the second calling party device (fig.3; col.5, lines 31-56, col.9, lines 27-67; 'new call' reads on the claim 'call request', 'connection' reads on the claim 'second call link' and 'called party and a first calling party' reads on the claim 'called party device and said second calling party device').

Malik further teaches causing a first message to be transmitted to the first calling party while the called party is in communication with the second calling party, whereby the called party can communicate information to the first calling party without interrupting communications with a second calling party (fig.3; col.5, lines 31-56, col.9, lines 27-67; 'first message' reads on the claim 'message', 'calling party' reads on the claim 'calling party device', 'called party' reads on the claim 'called party device', 'the first calling party' reads on the claim 'user of the first calling party device' and 'calling party' reads on the claim 'user of the calling party device').

Regarding claims 2 and 14, Malik teaches the message inherently instructing the first calling party to hold (fig.3; col.5, lines 31-56, col.9, lines 27-67; 'the first calling party' reads on the claim 'user of the first calling party device').

Regarding claims 5 and 17, Malik teaches that the message instructs the calling party device to leave a message (fig.3; col.5, lines 31-56, col.9, lines 27-67; 'the first calling party' reads on the claim 'user of the first calling party device').

Regarding claims 6 and 18, Malik teaches that the first calling party to be connected to a answering service associated with the called party (fig.1, fig.3; col.5, lines 31-56, col.9, lines 27-67; 'the first calling party' reads on the claim 'user of the first calling party device', 'answering service' reads on the claim 'messaging system' and 'the called party' reads on the claim 'user said called party device').

Regarding claims 7 and 19, Malik teaches the first message inherently comprising a prerecorded voice message (col.5, lines 31-56; 'first message' reads on the claim 'message').

Regarding claims 8 and 20, Malik teaches that a message to be transmitted to the first calling party comprises the step of the user selecting either the first message or second message associated with the called party (col.5, lines 31-56; 'the first calling party' reads on the claim 'user of the first calling party device' and 'either the first message or second message' reads on the claim 'one of a plurality of predefined messages using an input mechanism' and 'called party' reads on the claim 'called party device').

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 10, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. (U.S. Patent No. 6,167,119) and in view of Bull et al. (U.S. Patent No. 6,498,841).

Regarding claims 9 and 21, Malik fails to teach “generating a text message using an input mechanism associated with said called party device”. Bull teaches generating a text message using a text to speech module associated with said called party device (col.3, lines 38-67, col.4, lines 1-11; ‘text to speech module’ reads on the claim ‘input mechanism’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malik to allow generating a text message using an input mechanism as taught by Bull. The motivation for the modification is to have the generation in order to provide transmitted characters which make up the body of a message.

Regarding claims 10 and 22, Malik fails to teach “converting said text message to speech”. Bull teaches converting the text message to speech (col.3, lines 38-67, col.4, lines 1-11; ‘text to speech module’ reads on the claim ‘input mechanism’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malik to allow converting the text message to speech as taught by Bull. The motivation for the modification is to have the conversion in order to produce broad, unrelated and unpredictable vocabularies.

5. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. (U.S. Patent No. 6,167,119) and in view of Tatchell et al. (U.S. Patent No. 6,160,877).

Regarding claims 11 and 23, Malik fails to teach “call links between said called party device and said calling party devices are established through a packet-switched communications network”. Tatchell teaches that the signaling link is established through a packet switched

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network (col.6, lines 51-60; 'signaling link' reads on the claim 'call links between said called party device and said calling party devices' and 'packet switched network' reads on the claim 'packet-switched communications network'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malik to allow call links be established through a packet-switched communications network as taught by Tatchell. The motivation for the modification is to have the packet-switched communications network in order to carry data in the form of packets.

6. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. (U.S. Patent No. 6,167,119) and in view of Tatchell et al. (U.S. Patent No. 6,160,877) and further in view of Zhakov et al. (U.S. Pub. No. 2003/0021264).

Regarding claims 12 and 24, Malik in view of Tatchell fails to teach "call links are established using an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP)". Zhakov teaches that call links are established using a Session Initiation Protocol (SIP) (page no.3, paragraphs 0034-0035; 'Session Initiation Protocol (SIP)' reads on the claim 'an Internet Engineering Task Force (IETF) Session Initiation Protocol (SIP)'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Malik in view of Tatchell to allow call links be established using a Session Initiation Protocol (SIP) as taught by Zhakov. The motivation for the modification is to have the Session Initiation Protocol for creating, modifying and terminating communication sessions with one or more participants.

Allowable Subject Matter

7. Claims 3, 4, 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

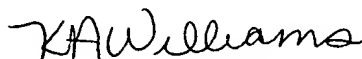
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703)305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

M. E.

MD SHAFIUL ALAM ELAHEE
April 21, 2003


Kimberly A. Williams
Primary Examiner
Technology Center 2600